



**UNITED STATES DEPARTMENT OF COMMERCE**  
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/195,368 11/18/98 ASHKENAZI

A 11669.26US03

EXAMINER

SUN HOFFMAN, L

ART UNIT

PAPER NUMBER

1642

DATE MAILED:

12/07/99

HM12/1207  
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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**09/195,368**

Applicant(s)  
**Ashkenazi et al**

Examiner  
**Lin Sun-Hoffman**

Group Art Unit  
**1642**



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-26 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-26 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

☒ notice to Seg Compliance

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1642

## DETAILED ACTION

### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-9, drawn to a nucleic acid, classified in class 536, subclass 23.1.
  - II. Claims 10-16, drawn to a polypeptide or its chimeric molecule, classified in class 530, subclass 350.
  - III. Claim 23, drawn to an antibody, classified in class 530, subclass 388.1.
  - IV. Claim 24, drawn to a method of inducing apoptosis in mammalian cancer cells, classified in class 514, subclass 2+.
  - V. Claims 25-26, drawn to a method of stimulating a proinflammatory response in mammalian cells, classified in class 514, subclass 2+.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I, II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions of invention I can be used for hybridization schemes, whereas inventions II and III cannot. Invention II can be used affinity purification schemes and to make antibodies, whereas the polynucleotides of invention I cannot, the antibodies of invention III can be used in immunoassays whereas the inventions I and II cannot.

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The inventions of Groups II and IV and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (i) the process for using the product as claimed can be practiced with another materially different product or (ii) the product as claimed can be used in a materially different process of using that product [see MPEP § 806.05(h)].

In the instant case, the proteins of invention II can be used to make antibodies, whereas the invention IV and V cannot. Invention IV can be achieved by using p53, whereas invention II and V cannot. Invention V can be achieved by other inflammatory related agent whereas inventions II and IV cannot.

The inventions of Groups I-IV are materially distinct methods which differ at least in objectives, method steps, reagents and/or dosages and/or schedules used, response variables, and criteria for success.

Due to the complexity of the restriction, a telephone call for election was not made.

Applicants are advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

3. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

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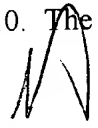
application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).


4. In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Paula Hutzell, Ph.D., Supervisory Patent Examiner at Paula.Hutzell@uspto.gov or 703-308-4310. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lin Sun-Hoffman, Ph.D., whose telephone number is (703)-308-7552. The examiner can normally be reached on Monday to Friday from 7:30 am to 4:00 pm Eastern Standard Time.

7. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell, Ph.D., can be reached on (703) -308-4310. The fax phone number for this Group is (703)-308-4242.

Lin Sun-Hoffman, Ph.D.

  
ANTHONY C. CAPUTA  
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TECHNOLOGY CENTER 1600

  
December 6, 1999